

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number 042933/253104

(filed with the Notice of Appeal)

Application Number 09/977,895

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First Named Inventor Cheol-Woong Lee

Art Unit 3621

Examiner Winter, John


Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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Date July 22, 2008

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Attachment  
Reasons for Requesting Pre-Appeal Brief Request for Review

Claims 11-13 and 16-19 currently stand rejected under 35 U.S.C. §103(a), as being unpatentable over Hale et al. (U.S. Patent No. 6,732,180, hereinafter “Hale”) in view of Rabin et al. (U.S. Patent No. 6,697,948, hereinafter “Rabin”) and further in view of Cooper et al. (U.S. Patent Application Publication No. 2001/0051996, hereinafter “Cooper”).

Independent claims 11 and 12 recite, *inter alia*, determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network. The Office Action admits, and Applicants agree, that neither Hale nor Rabin provides any teaching or suggestion regarding determining which music files have a high probability of being copied. Accordingly, the Office Action relies upon Cooper for disclosing such feature. Applicants respectfully disagree.

In this regard, the Office Action cites paragraphs [0074] to [0077] of Cooper as disclosing the above recited feature. However, the cited paragraphs of Cooper merely relate to a system for authenticating the validity of digital certificate IDs associated with downloaded files. In this regard, Cooper describes efforts to match the digital certificate on a device to digital certificate ID numbers. If no match can be made a counter will accumulate and, if a threshold count is reached, a letter will be sent to the owner of the digital certificate. There is no indication in the cited passage or any part of Cooper that such a count is associated with determining a file with a higher probability of being reproduced by another user than other music files. To the contrary, the above described mechanism operates for all downloaded files that have a particular marking thereon. The marked files are also not disclosed as having any relationship to any determination regarding a digital music file that has a higher probability of being reproduced.

Of note, Cooper does disclose in paragraph [0073] that only certain content files may be downloaded by an ALAM module. The certain files may be “files that are determined to have a high probability of being in a place that is not approved by the right owner”. Thus, the probability determination that is disclosed in Cooper is associated with whether or not a file is in a location that is unapproved and has no relationship to determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication as recited in

independent claims 11 and 12. Moreover, if the file is in a place not approved by the right owner, the probability of Cooper relates to a probability that the file has already been illegally reproduced and has no relationship to any future action associated with the file much less any probability of being reproduced. Thus, Cooper also fails to teach or suggest the above recited feature of independent claims 11 and 12.

Since Cooper, Hale and Rabin all fail to teach or suggest determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication as recited in independent claims 11 and 12, any combination of Cooper, Hale and Rabin also fails to teach or suggest such feature. Thus, independent claims 11 and 12 are patentable over Cooper, Hale and Rabin, alone or in combination. Claims 13 and 16-19 are therefore also patentable over Cooper, Hale and Rabin, alone or in combination, due to their dependency from independent claims 11 and 12.

Notably, however, there are yet further reasons for the patentability of at least some of the dependent claims. In this regard, Applicants note initially that none of the features of dependent claims 16-19 are asserted to be taught or suggested by any of the cited references in any manner other than the blanket statement that all such claims are not patentably distinct. Applicants respectfully submit that this is completely incorrect. For example, claims 18 and 19 further define that determining a file having a higher probability of being reproduced includes selecting one digital music file among a plurality of digital music files such that the identified digital music file is selected based on having a greater number of other digital music files having two or more of a same name, size and playing time as the identified digital music file than other music files related to the digital music file illegally distributed through the computer communication network. No portion of any of the cited references is cited in connection with supporting the rejections of these claims. To the contrary, the final Office Action merely lumps all these claims together and asserts that they are not patentably distinct from claims 11-13. Applicants respectfully submit that the subject matter of claims 16-19 is most certainly patentably distinct from the recitations of independent claims 11 and 12, respectively. Moreover, for example, even the most cursory of inspections of claims 18 and 19 indicates substantial differences between the recitations therein and the recitations of claims 11 and 12. Thus, not

only is the statement in the Office Action incorrect, but these claims certainly deserve a proper examination on the merits.

Applicants respectfully submit that MPEP 707.07(d) provides that, “A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. Since each of the dependent claims recites additional features that are not included in their respective independent claims, and since such differences are plainly evident by even the most cursory of inspections, each dependent claim is by definition different than its respective independent claim and any rejection directed only to the features of the independent claim would not be equally applicable to the respective dependent claims. Thus, the lumping of these claims together as being patentably indistinct from the independent claims is improper.

Furthermore, Applicants note that 37 CFR 1.104 provides that, “The examiner’s action will be complete as to all matters.” However, Applicants assert that the final Office Action is not complete since the provisions of MPEP 707.07(d) have not been met. The improper grouping of these claims under the MPEP represents a failure to properly examine these claims, which Applicants respectfully assert renders the final Office Action improper, since Applicants have not been given a fair opportunity to respond to proper rejections. Moreover, the features recited in claims 16-19 are not taught or suggested in any of the cited references.

Accordingly, for all the reasons above, Applicants respectfully submit that the rejections of claims 11-13 and 16-19 should be overturned.